

Remarks

Applicant respectfully traverses the restriction requirement and requests withdrawal of same. According to MPEP §803.01, criteria for restriction between patentably distinct inventions have two separate requirements: (1) the invention must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is required.

Applicant respectfully disagrees that the claims, as presently presented, would in any way create a serious burden to search or otherwise examine. Regardless of whether a patent application claims inventions that are "independent" or "distinct", a restriction should not be made if a search and examination of the entire patent can be made without serious burden (MPEP §803). Accordingly, the claims as presently restricted cover overlapping subject matter; namely compositions and methods drawn to use of a DG931 molecule. Applicant respectfully traverses the restriction requirement and, as the search across Groups I-X would be largely coextensive and not create a serious burden on Examiner, requests all claims be examined together.

The requirement for election of species is traversed on the grounds that the species of the invention recited in all of the pending claims are so closely related that there is no proper basis for requesting such an election. M.P.E.P. § 806.03 states: "Where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition." Further, the both the Rules and MPEP clearly state

that an applicant is permitted to a "reasonable number" of species (MPEP § 806.04; 37 C.F.R. § 1.141).

In the present application, Examiner has cited the requirement to elect SEQ ID NO:1 or SEQ ID NO:2 because "[e]ach sequence represents structurally different nucleic acid and/or amino acid sequences." As stated in the present application, SEQ ID NO:1 is the nucleotide sequence of human DG931 and SEQ ID NO:2 is the corresponding amino acid sequence of human DG931 (see specification, p. 5). The relatedness between the two sequences traverses the requirement for a single election of species. Moreover, Applicant respectfully submits the species requirement as improper; having two sequences, one being the polynucleotide sequence with the other being the corresponding amino acid sequence, which read on the same ultimate product (the DG931 protein) would seem to be a reasonable number. The details of the particular sequences, whether polypeptide or nucleic acid, do not alter the essential characteristics of the invention. In fact, the pending claims define the same essential characteristics of a single disclosed embodiment of the invention, that being the DG931 protein. Applicant does not traverse the requirement for election of species on the grounds of lack of patentable distinctness between the species. Rather, Applicant traverses the requirement for election of species on the grounds that the relatedness of the species precludes the requirement for election, notwithstanding possible patentable distinctness between the species.

The above is valid with respect to the election of product requirement; namely, the election between a nucleic acid molecule encoding DG931, an effector, a modulator or DG931 protein. Electing one product out of those mentioned above is improper in light of the relatedness between the various

products. The above are all considered essential characteristics of a single disclosed embodiment of the present invention.

This response is being submitted concurrently with the fees for a two month extension of time. However, authorization is granted to charge Deposit Account No. 502-235 for any underpayments.

Respectfully submitted,



David M. Kohn, Esq.
Registration No: 53,150

Date: June 7, 2007

CATALYST LAW GROUP, APC
9710 Scranton Rd., Suite 170
San Diego, CA 92121
(858) 200-0586